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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,458	12/16/2003	Ulrich Rohs	ROHS-12/11	9583
20151	7590	08/19/2005	EXAMINER	
HENRY M FEIEREISEN, LLC 350 FIFTH AVENUE SUITE 4714 NEW YORK, NY 10118			BINDA, GREGORY JOHN	
		ART UNIT		PAPER NUMBER
				3679

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/738,458	ROHS ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Greg Binda	3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 July 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19, 23 and 24 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19, 23 and 24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 July 2005 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. 09/349,264.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The amendment filed July 19, 2005 is objected to because claim 16 is identified as "original" but the text includes change markings.

*Drawings*

3. The drawings are objected to because the clearance described in paragraph 00058 needs to be clearly identified (i.e. by reference character) in the drawings.
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

5. The disclosure is objected to because:

- a. In line 8 of the paragraph inserted after paragraph 0041 the word “ratio” is misspelled.
- b. Paragraph 0049 begins with the phrase “As clearly shown in paragraph [0047]”. This phrase is inappropriate for at least two reasons. First, the text of a paragraph discloses or describes. It does not “show”. Secondly, and more importantly, paragraphs are not numbered in a U. S. patent. As such the term, “paragraph [0049]” would be meaningless in a patent issuing from this application.
- c. Paragraphs 0051 and 0053-0056 mention a Figure 10, but there is no such figure in the disclosure.
- d. Paragraph 0058, line 6 (as amended) includes the nonsensical term “FIGS. 8”.
- e. Paragraph 0058 includes the phrase, “while it is possible to avoid that the right hand piston 30 leaves its receiving position and prevents an engagement”. The phrase does not make sense. Whatever thought applicant is attempting to convey therein, needs to be written in proper idiomatic English.
- f. Paragraphs 0058 & 0059 refer repeatedly to a spring 31 as it relates to what is shown in Figs. 8 & 9. However, neither figure includes a spring 31.

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g. Paragraph 0059 states "a same guiding length" and "at same maximum rotational angle, the spring element 31 can exhibit a considerably longer guidance." What do "same guiding length" and "same maximum rotational angle" mean. Are there different lengths and rotational angles having a "same" value? By what reference is the "guidance" longer? It seems as though a comparison is being attempted in paragraph 0059, but the attempt is clumsy and incomprehensible.

6. A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because due to the excessive changes and corrections to changes present in this specification. In accordance with 37 CFR 1.125(b), the substitute specification must be accompanied by a statement affirming the substitute specification includes no new matter.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

*Claim Rejections - 35 USC § 112*

7. Claims 1-19 & 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has not pointed out where the following limitations are supported, nor does there appear to be a written description of the limitations in the application as originally filed:

- a. Claim 1, line 15: "a restoring force which increases with increase in the relative rotation of the first and second assemblies".
- b. Claim 7: "in the second phase [the thrust piston] is radially tilted".
- c. Claim 8: "a recess for mutual engagement [between two thrust pistons]. . . at a particular relative angle between the two subassemblies"
- d. Claims 14 & 16: all limitations therein
- e. Claim 24: "in the second phase, the thrust piston moves into a tilted position"

8. Claims 6, 7, 9-11 & 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim 6, line last recites the limitation "said guide surface". There is insufficient antecedent basis for this limitation in the claim.
- b. Claim 7, line last recites the limitation "the first position". There is insufficient antecedent basis for this limitation in the claim.

c. Claim 9, line last recites the limitation "the respective recess of each thrust piston".

There is insufficient antecedent basis for this limitation in the claim.

d. Claim 23, lines 14-17 recites the limitation, "a translation of a movement of said first assembly . . . varies with the size of the relative angles of rotation between said two subassemblies". The meaning of the limitation is unknown.

#### *Response to Arguments*

9. Applicant's arguments filed July 19, 2005 have been fully considered but they are not persuasive.

a. With regard to item 7a, applicant argues this limitation is supported in the paragraph inserted by amendment after paragraph 0041. However, that paragraph makes no mention of a restoring force. Nor was this particular paragraph present in the original application.

e. With regard to items 7b & 7e, applicant argues this limitation is supported in the paragraph inserted by amendment after paragraph 0041. However, that paragraph makes no mention of a second phase. Nor was this particular paragraph present in the original application.

f. With regard to item 8b, applicant claims to be "at lost" because the limitation "the first position" allegedly fails to appear in the claim. However, the limitation did and still does appear in claim 7. See the last line of the claim.

g. With regard to item 8d applicant argues the limitation is accepted by the Examiner per an interview. However, as noted in the examiner's summary of that interview,

“translation” was defined as a difference in movement between a piston and a subassembly. That definition has nothing to do with so-called “translation” recited in claim 23, lines 14+, which is a “translation of a movement” of said first subassembly in relation to the relative rotation of the subassemblies, not a piston.

*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda  
Primary Examiner  
Art Unit 3679